

### REMARKS

Claims 1-9 and 11-56 are presently pending. Claims 1, 8, 13, 22, 29, 35 and 44 have been amended. Claim 10 was previously canceled. Claims 53-56 remain withdrawn as being directed to nonelected species.

Applicant respectfully requests reconsideration of the application in view of the foregoing amendments and the remarks appearing below.

#### Rejection under 35 U.S.C. § 112, First Paragraph

##### *Written Description*

The Examiner has rejected claims "1-9 and 11-55" [sic?] under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

First, the Examiner states that the "applicant identifies the invention as a method for identifying a range of eligible aspects of an invention" and poses the question, "What are eligible aspects?" [Emphasis added.] Applicant believes the examiner may have misread the amended claims, and this misreading has led to the present rejection. How the claims at issue (see, e.g., claim 1) actually read is, "A method of identifying a range of patent eligible aspects of an invention . . . ." [Emphasis added.] Indeed, the correct language is not just "eligible aspects," but rather "patent eligible aspects." The present application contains much description regarding the identification of a variety (i.e., "range") of features, characteristics, etc. (i.e., "aspects") of an invention that are patentable or, more broadly, "patent eligible." It is Applicant's position that the term "patent eligible" is more appropriate than "patentable" because not every patent eligible aspect of an invention will always be patentable, since the ultimate determination of patentability depends on many factors, including the prior art, and is at times somewhat subjective, e.g., in the case of an obviousness analysis.

It is Applicant's position that not only does the term "patent eligible aspects" satisfy the written description requirement, but it is also definite. There is a plethora of statutory law (e.g., 35 U.S.C. § 100 et seq.), case law, codified procedures (e.g., MPEP chapter 2100) and other matter that defines what patent eligible aspects of inventions are.

For at least the foregoing reasons, Applicant respectfully requests that the Examiner withdraw the present rejection.

Second, the Examiner asks what a "selected pair" is, e.g., as appears in claim 1, clause (a). The intent of using the term "selected pair" as opposed to simply "pair" was to make the rest of the claims easier to read. Applicant's belief was that the subsequent occurrences of "said selected pair" provides the reader more information than just "said pair." That said, Applicant now sees why the Examiner is questioning the language. The step of "selecting a selected pair" implies that there was a selection made prior to the performance of this selecting step. Since this implication causes confusion, Applicant has amended the claims to recite "selecting a pair" in lieu of "selecting a selected pair."

For at least the foregoing reasons, Applicant respectfully requests that the Examiner withdraw that present written description rejection.

#### ***Enablement***

The Examiner has rejected claims 1-9 and 11-52 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Applicant respectfully disagrees.

#### ***Ladder of Abstraction***

The Examiner appears to indicated at the end of the first paragraph on Page 3 of the present Office Action that Applicant has not enabled the step of working through a ladder of abstraction. Applicant respectfully disagrees.

A ladder of abstraction is a well-known creativity tool that provides a continuum of "general" (or "broad") to "specific" (or "narrow") on one rail of the ladder (visualize a conventional climbable ladder having two longitudinal rails supporting steps or rungs) and the corresponding continuum of "abstract" to "concrete" on the other rail. The steps, or rungs, of the ladder are discrete locations for specific items of the subject matter to which the ladder of abstraction is applied. Examples of ladders of abstraction in various contexts can be found by conducting a general search on the Internet using the query "ladder of abstraction" and reviewing the Webpages of the search results.

In the context of the present invention, the step of "working" a ladder of abstraction is discussed in detail at pages 12-14 of the present application. As a broad summary, a ladder of abstraction may be worked in the context of the present invention by asking "why" questions to work "up" the ladder toward the abstract and asking "how" questions to work "down" the ladder toward the more concrete. Applicant asserts that anyone skilled in the relevant art would readily understand how to work a ladder of abstraction in the context of the present invention after

reviewing the present patent application. Indeed, this is the test for enablement, i.e., whether someone skilled in the art can practice the claimed invention based on the disclosure of the invention. See, e.g., MPEP § 2164. Although the concept of a ladder of abstraction is not well-known to the general public, it is indeed well-known in the relevant art in which the present invention lies. This is all that is required by the law to satisfy the enablement requirement.

#### **Identifying a Range of Patent Eligible Aspects**

The Examiner appears to indicate that the step of iterating the steps of selecting a pair of an invention type and a life cycle aspect so as to identify a range of patent eligible aspects of an invention is not enabled. In particular, the Examiner states that the present application does not identify what such a range is and questions how one skilled in the art knows how to identify a range of patent eligible aspects. Applicant believes that those skilled in the art would readily know how to identify a range of patent eligible aspects.

In a meaning relevant in the context of the present invention, "range" is defined as a variety of different things. See, e.g., [www.onelook.com](http://www.onelook.com), the Encarta online dictionary, the Miriam Webster online dictionary, etc. "Patent eligible aspects" are as discussed above in the argument relating to the written description rejection. Consequently, all that is required in identifying a range of patent eligible aspects of an invention with these meanings is that more than one differing features, characteristics, etc. of an invention be identified, wherein the differing features, characteristic, etc. are subject matter eligible to be patentable. Having read the present application, those skilled in the art could surely identify such a range of patent eligible aspects of an invention.

#### **Modifying the Aspect**

On page 4 of the present Office Action, in the fifth and fourth lines from the bottom of the page, the Examiner states that "applicant also claims a step of modifying the aspect" and poses the question, "How does one modify the aspect?" This is not correct. In the prior amendments of the claims, Applicant removed the language, "modifying said first aspect" and similar language. See Applicant's Response filed August 25, 2005. It appears that this rejection is an artifact from the Office Action of May 27, 2005. Since the present claims do not have a step of modifying an aspect, the present rejection is moot.

### **Holding an Invention Type Constant and Exhausting a Plurality of Life Cycle Aspects**

On page 5 of the present Office Action, the Examiner appears to indicate that the limitations of holding an invention type constant and exhausting a plurality of life cycle aspects are not enabled and poses the question, "How does one determine which of the plurality of invention types to hold constant and how is it determined when all of the plurality of life cycle aspects have been exhausted?" Applicant respectfully disagrees that these limitations are not enabled.

Regarding holding an invention type constant, FIG. 2 of the present application and accompanying description thereof clearly illustrate how an invention type, e.g., method, is held constant while working through a ladder of abstraction (represented by elements 110A-C in corresponding respective ones of the three life cycle aspects shown) and working relative to each of a plurality of life cycle aspects. That is, the method invention type is evaluated in each of three different life cycle aspects by working a corresponding respective ladder of abstraction, again represented by elements 110A-C. Clearly, the invention type (method) is held constant while working three separate ladders of abstraction 110A-C, i.e., while varying the life cycle aspects among the three illustrated. This cycling would be done for any two or more invention types relevant to the invention being evaluated. Applicant submits that with an understanding of FIG. 2 and accompanying description thereof, anyone skilled in the art would understand what is meant by holding an invention type constant and how to determine which invention type to hold constant. Regarding the latter, each invention type selected for a particular invention may be held constant while cycling through life cycle aspects and working through corresponding ladders of abstraction.

Regarding exhausting a plurality of life cycles, this limitation is also clearly enabled by the present application, e.g., relative to FIG. 2 and the text that describes FIG. 2. A plain and ordinary meaning of "exhaust" is to use something up. Again, see, e.g., [www.onelook.com](http://www.onelook.com), the Encarta online dictionary, the Miriam Webster online dictionary, etc. Consequently, "exhausting all of said plurality of life cycle aspects" (claim 13, clause (c)) is to use up the plurality of life cycle aspects. In the context of the present invention, those skilled in the art will clearly understand this "exhausting" limitation to mean that for each of the plurality of life cycle aspects considered (e.g., the three shown in FIG. 2), a ladder of abstraction is worked through for each of

the invention types at issue. Once a ladder of abstraction has been worked through for each of the invention types considered relative to a particular life cycle aspect, that life cycle aspect is used up, i.e., "exhausted."

For example, in the context of FIG. 2 of the present application, assuming that all six of the invention types shown under life cycle aspect 214B "Make/Supply" are under consideration, then this life cycle aspect would be "exhausted" (used up) after six ladders of abstraction (one for each invention type) have been worked through. Assuming that all six invention types are under consideration for all three life cycle aspects 214A-C, all of them would be exhausted after eighteen ladders of abstraction (one for each invention type in each of the three groups) have been worked through. Clearly, there is nothing here that would be the subject of undue experimentation.

#### **Listing at Least Some of the Patent Eligible Aspects**

On page 5 of the present Office Action, the Examiner indicates that the claims include a limitation of generating a list containing at least some of the patent eligible aspects in the range of patent eligible aspects. The Examiner then asserts that Applicant has not defined how the at least some of the patent eligible aspects are chosen to be included in the list. Applicant respectfully disagrees.

At page 20, line 15-30, Applicant described that a larger list of inventions may be reduced to a smaller list by considering business related issues. In addition, a common patent claim drafting practice is to craft certain limitations used in connection with "plurality-type" limitations so as to not unnecessarily limit claims. For example, in the present claims that recite identifying a range (i.e., a plurality) of patent eligible aspects (claim 1, for example), Applicant used the "at least some of said patent eligible aspects" to avoid not literally capturing the scenario that one or more aspects identified are inadvertently left off the list or the scenario that one or more aspects are purposely left off the list, e.g., if it is determined that certain aspects are pre-judged to be of questionable value. Applicant believes that this drafting technique should not trigger an enablement issue in the present claims. None of the reasons just mentioned or other reasons leading to a reduced list would cause undue experimentation.

For at least the foregoing reasons, Applicant respectfully requests that the Examiner withdraw the present enablement rejections.

**Rejections under 35 U.S.C. § 112, Second Paragraph**

The Examiner has rejected claims 1-9 and 11-52 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention.

In part 4, page 5 of the Office Action, the Examiner makes this rejection twice, but does not provide any details. Consequently, the Applicant is not able to provide any detailed arguments refuting the rejection. If the Examiner makes this rejection again, Applicant respectfully requests that the Examiner list the details of the rejection so that the Applicant has an opportunity to provide a detailed response.

For the record, Applicant does not believe that any of the claims, as amended, are indefinite. Therefore, Applicant respectfully requests that the Examiner withdraw the indefiniteness rejection.

**Rejection under 35. U.S.C. § 101**

The Examiner has rejected claims 1-52 under 35 U.S.C. § 101 as being directed to nonstatutory subject matter. In particular, the Examiner states that the invention as claimed is not within the technological arts and does not produce a concrete result because it does not produce a repeatable and predictable (and thus, concrete) result.

It appears that the Examiner's primary point of contention is that because the claimed method involves subjective mental processing, there cannot be any predictable or repeatable result. Since there is not a predictable and repeatable result, so the argument goes, the result is not concrete and, thus, fails the concreteness prong of the tripartite useful/tangible/concrete test. Applicant respectfully disagrees that the result of the steps of the claimed method is not concrete.

First Applicant notes that in part 5, on page 6 of the Office Action, the Examiner uses the term "mental steps" (end of the first paragraph). Lest there be any question on the matter, Applicant wishes to point out that the "Mental Step Test" and the "Human Step Test" "are not to be applied by examiners in determining whether the claimed invention is patent eligible subject matter." Annex III, Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, USPTO, October 26, 2006. [First emphasis in original, second emphasis added to highlight that the meaning of "patent eligible aspect" as used in the claims is indeed a term well known in the art.] More particularly, Annex III states that processes are not non-statutory simply because some or all of the steps of a claim can be carried out in a human

mind or because it may be necessary for a person performing the process to do some or all of the process steps. That said, Applicant now turns to the reason why the results of the claimed method are indeed concrete.

In assessing whether results of a claimed process meet the concreteness requirement, the assessor must determine what is the result to be evaluated for repeatability and predictability. In the present case, Applicant asserts that a proper result for scrutiny under the concreteness analysis is a list containing at least some of the patent eligible aspects identified as a result of the steps of the method. Every time a claimed method of the present invention, e.g., the method of amended claim 1, is performed, the result will most certainly be a list containing at least some of the patent eligible aspects of an invention at issue. Applicant submits: 1) that there is no reasonable way to dispute that this result is repeatable—the list will result every time the method is performed and 2) that there is no reasonable way to dispute that the result is predictable—the list will always contain at least some of the patent eligible aspects identified via other steps of the method. Since the result of the claimed method is both repeatable and predictable, under current case law the result is concrete. Therefore, the claimed methods (processes) are statutory. (For completeness, the result is also useful and tangible in accordance with the other two prongs of the tripartite statutory eligibility test.)

Applicant conjectures that the Examiner's concern about concreteness is based on the fact that any two skilled artisans performing the claimed method for the same invention will invariably generate lists having differing content, i.e., lists having at least some differing patent eligible aspects. While this is virtually certainly true, it is of no moment to the concreteness analysis. Again, concreteness goes to the fact that any two skilled artisans practicing the claimed method will always generate respective lists each containing at least some of the patent eligible aspects that they identified in preceding steps of the method. To hold otherwise would be to say that any claim that produces an output that varies as a function of the input is unpatentable. This is simply not the case in patent law. Relative to the present claims, some of the input comes from human minds that have inherent variability. However, even with this variability, the result, not the content of the result, of the claimed method is exactly the same repeatable and predictable result—a list containing at least some of the identified patent eligible aspects.

To illustrate that concreteness is not tied to variable input and output, Applicant again presents the following in claim 1 of U.S. Patent No. 5,190,458 to Driesener:

1. A method of psychological testing of a person, comprising:
  - (a) instructing the person to produce a drawing which includes at least one pictorial representation of each of at least a majority of the following items: a hand, an eye, a tree, a fish, a star, a spiral; a half-circle, and a zig-zag; and
  - (b) subjecting to psychological interpretation the drawing produced in response to step (a).

What is the result of this claim and is it concrete? If one were to assert that the content of the result, i.e., the outcome of the psychological interpretation, is the "result" for the concreteness analysis, there would indeed be an argument (though not necessarily a winning argument) that such a result is not predictable and repeatable because of the involvement of human minds being both the subject of the interpretation and the object performing the psychological interpretation. Indeed, the subject matter of the Driesener claim is rife with variability.

However, the U.S. Patent and Trademark Office obviously deemed the Driesener claim to be directed to patentable subject matter. Applicant submits that the reason for this is because the question of concreteness goes to the result achieved, not the content of the result. In the Driesener example, the result is the occurrence of a psychological evaluation, not the interpretive details of the evaluation. Similarly, in the present application, the result is the generating of a list of at least some of the patent eligible aspects in the range of such aspect, not the aspects in and of themselves.

For at least the foregoing reasons, Applicant believes that the amended claims are indeed statutory under 35 U.S.C. § 101. Therefore, Applicant respectfully requests that the Examiner withdraw the present rejection.

#### **Rejection under 35. U.S.C. § 103**

The Examiner has rejected claims 1-9 and 11-52 under 35 U.S.C. § 103 as being obvious in view of the paper, Paley, Mark Aaron, "A Model Software Petite Patent Act," August 1996, stating that Paley discloses the method of identifying a range of patent eligible aspects of an invention recited in independent claims 1, 8, 13, 22, 29, 35 and 44, except for the step of generating a list containing patent eligible aspects of an invention. The Examiner then asserts that the step of generating lists is well known and that it would have been obvious to a person having ordinary skill in the art at the time of the invention to add the step of generating a list to the Paley method. Applicant respectfully disagrees that the Paley paper discloses all steps of the claimed method except the step of generating a list of patent eligible aspects of an invention.



The Paley paper discusses, among other things, the question of whether or not software is statutory subject matter. Notably, the Paley paper is completely silent on a number of limitations of the amended claims. For example, the Paley paper does not deal with generating a range of patent eligible aspects of a particular invention, and the Paley paper is completely silent on working through a ladder of abstraction so as to identify patent eligible aspects. Nor would it be obvious to add these limitations to the Paley paper to arrive at the claimed invention.

In addition, Applicant asserts that many of the dependent claims likewise contain subject matter not disclosed by or obvious in view of the Paley paper.

For at least the foregoing reasons, Applicant respectfully requests that the Examiner withdraw the present rejection.

### Conclusion

In view of the foregoing, Applicant respectfully submits that claims 1-9 and 11-52, as amended, are in condition for allowance. Therefore, prompt issuance of a Notice of Allowance is respectfully solicited. If any issues remain, the Examiner is encouraged to call the undersigned attorney at the number listed below.

Respectfully submitted,

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